

U.S. Appl. No. 09/715,453
Amendment Dated Apr. 18, 2004
Reply to Office Action of Nov 18, 2004
Docket No 6169-134

IBM Docket No. BOC9-1999-0074

REMARKS/ARGUMENTS

These remarks are submitted responsive to the office action dated November 18, 2004 (Office Action). As this response is timely after the three-month statutory period, a petition for an extension of time and corresponding fee is included herein.

In paragraph 1 of the Office Action, the Examiner indicates that claims 1-26 and 32-52 are presently pending in the current application.

In paragraphs 2-14 of the Office Action, the Examiner has rejected claims 1-9, 21, 32-50 and 52 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,918,013 to Mighdoll, *et al.* (Mighdoll). In paragraphs 15-18, the Examiner has rejected claims 22-24 under 35 U.S.C. § 102(e) as being anticipated by "SlipKnot". In paragraphs 19-27 of the office action, the Examiner has rejected claims 10, 13, 41 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Mighdoll in view of U.S. Patent No. 6,119,135 to Helfman (Helfman). Additionally, in paragraphs 28-31, the Examiner has rejected claims 12 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Mighdoll in view of U.S. Patent No. 6,088,718 to Altschuler, *et al.* (Altschuler). Claims 14, 15, 17, 19, 45, 46, 48 and 50 are rejected by the Examiner in paragraphs 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Migdholl in view of "official notice". In paragraphs 36-45, the Examiner has rejected claims 16, 18, 20, 47, 49, and 51 under 35 U.S.C. § 103(a) over Mighdoll in view of SlipKnot. Finally, in paragraphs 46-52 of the Office Action, the Examiner has rejected claims 25-26 under 35 U.S.C. § 103(a) over SlipKnot in view of Mighdoll.

In response to the Office Action, Applicants have amended claims 1 and 32 to include the steps of: presenting hypermedia content, said hypermedia content containing hyperlinks to additional hypermedia content; receiving a user selection of at least one of said hyperlinks; storing user selected ones of said hyperlinks in a delayed viewing list; and, caching hypermedia content associated with said stored hyperlinks during said presenting step, wherein the hypermedia content is presented to a user during said

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receiving, storing, and caching steps. Support for these amendments can be found at page 9, lines 10-17, page 18 line 21 to page 19, line 3, and throughout the specification.

Claims 3 and 34 have been amended to clarify that the hyperlink is selected by a right-mouse click, as supported by page 14, lines 25-28. Claims 4 and 35 have been amended to clarify that a video stream can be presented in an uninterrupted fashion during said receiving, storing, and caching steps, as supported between page 18 line 22 to page 19, claim 3, by FIG. 1B, and by page 13, lines 15-25. Claims 6 and 37 have been amended to signify that the cache can be remotely located from the content browser, as shown in FIG. 1B, item 116, 150, and 115, and throughout the specification. Claims 7 and 38 have been amended to clarify that the local cache can be disposed within the client of the content browser, as supported by FIG. 1A, items 111 and 116, and the associated specification sections.

Claims 14 and 45 have been amended to indicate that the purging step can occur automatically, as supported by page 17, line 12. Claims 15 and 46 have been amended to indicate that the purging step can be a manual one, as supported by page 17, lines 20-22. Claims 16 and 47 have been amended to indicate the delayed viewing list can be managed via a DVL manager interface, as supported between page 17, line 25 to page 18, line 10. Claims 17 and 48 have been amended to indicate the hypermedia links are automatically purged once the content referenced by the links has been presented, as supported by page 17, lines 12-13.

Claim 22 has been amended to clarify that a user can select a hyperlink from within the content browser, and that view presented within the content browser is not relinquished when downloaded user selected content, as supported by page 9, lines 14-16, and page 14, lines 25-28. Claim 23 has been amended to clarify that a user can select a hyperlink via a right mouse click, as supported by page 14, lines 25-28. Claim 24 has been amended to clarify that the content browser can stream video without interruption,

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as supported between page 18 line 22 to page 19, claim 3, by FIG. 1B, and by page 13, lines 15-25.

No new matter results from these amendments.

Before addressing specific rejections on the art, a brief review of the Applicants claimed invention and the cited references may be helpful. The Applicants have invented a delayed viewing list (DVL), where a user can be presented with hypermedia content including hyperlinks to other hypermedia content. The user can select one or more of these links while viewing the presented content. For example, a user can right-click on a selected hyperlink acting a floating menu with an menu option to add the hyperlink to the delayed viewing list (page 14, lines 25-28). A background agent can retrieve hypermedia documents and content thereof for the use specified hyperlink (page 15, lines 21-23). The retrieval can occur without relinquishing the view currently being presented within the content browser (page 9, lines 14-17).

In one embodiment, the user can browse the hypermedia content using a set top box and a TV system, where the hypermedia content and hyperlinks can be combined with TV content, where the selection and placement of the hyperlinks within the DVL does not interfere with the presentation of the TV content (page 13, lines 10-15 and page 18 line 21 to page 19, line 3).

A. Mighdoll fails to anticipate the claimed invention

Claims 1-9, 21, 32-50 and 52 have been rejected under 35 U.S.C. § 102(e) as being anticipated Mighdoll.

Mighdoll teaches a transcoding proxy server. The proxy server is a communication intermediary between a client and a Web server. Mighdoll teaches that the client can be a WebTV™ client connected to a television. Televisions typically have less stringent parameters than monitors, and presenting unaltered Web content upon a television can result in blurry images. The transcoding proxy server can alter the Web

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content via transcoding technologies as to make Web content viewable upon a standard television screen. The purpose of Mighdoll is to transcode Web content so that this content so that the content is more suitable for use by the client.

In claims 1 and 32, Applicants expressly claim:

presenting hypermedia content, said hypermedia content containing hyperlinks to additional hypermedia content;

receiving a user selection of at least one of said hyperlinks;

storing user selected ones of said hyperlinks in a delayed viewing list; and,

caching hypermedia content associated with said stored hyperlinks during said presenting step, wherein the hypermedia content is presented to a user during said receiving, storing, and caching steps.

Mighdoll fails to teach receiving a user selection of a presented hyperlink. Instead, Mighdoll's process is an automated one, focusing upon transcoding, where a proxy server can utilize a document database (column 5, lines 48-57). The document database is used to speed up processing and downloading of a document, once that document has been previously retrieved by the server (column 5, lines 30-34). That is the document database is a cache of past Web sites stored in anticipation of re-use.

In contrast, the Applicants' claimed invention is a user (not server) driven process, where a user can detect to pre-fetch data without otherwise disturbing their present Web browsing session (note from the claims that the hypermedia content is presented to a user during said receiving, storing, and caching steps, steps where content contained within user selected hyperlinks of the hypermedia content is processed).

Applicants take a moment to clarify the "server advised client prefetching" detailed in column 12 Mighdoll, which may have been misconstrued by the Examiner (or construed correctly, but rendered moot in light of the currently amended claims).

The "prefetching" detailed in column 12, lines 28-38, is used to speed up image processing. Normally retrieving images via the Internet can be time consuming.

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Mighdoll teaches that Images contained within previously retrieved documents (column 12, line 31) can be stored by the proxy. The next time, the same document is requested by the client, the stored images can be used (column 12, lines 33-39) by the proxy and provided to the client. Notably, document database 61 is instrumental for the prefetching (column 12, lines 28-31) and the document database includes stores information "after a document has once been retrieved by the server" (column 5, lines 30-35).

Mighdoll also teaches "server advised client pre-fetching," where the server is again the transcoding proxy (column 12, lines 40-50). Here, the document database is again used (column 12, line 40). The transcoding proxy (server) can inform the client of "popular images or links." Popular links defined by the document database would include items that have already been cached (like images or previously stored documents). The server can provide indicators of these already cached items (column 12, lines 49-50).

In summary, Mighdoll fails to teach a user selection process for selecting hyperlinks within currently presented hypermedia content. That is, the Applicants claim a user initiated pro-active content retrieval methodology and Mighdoll discloses a server (proxy) initiated utilization of a memory cache (retro-active, meaning after the content has been used in previous browsing sessions).

From the above, it is clear that Mighdoll does not explicitly or implicitly teach each of the Applicants' claimed limitations. Specifically, Mighdoll fails to teach the pro-active, user-initiated retrieval of Web content. Mighdoll also fails to teach that Web content is identified by a user, retrieved, and stored, while content containing links to the identified content is still being presented to the user. Since Mighdoll fails to teach each claimed limitation, the 35 U.S.C. § 102(e) rejections to claims 1-9, 21, 32-50 and 52 should be withdrawn, which action is respectfully requested.

B. SlipKnot fails to anticipate the claimed invention

Claims 22-24 under 35 U.S.C. § 102(e) as being anticipated by "SlipKnot".

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SlipKnot teaches a menu items called "get all links" that can be added to a content browser. Selection of this item presents a new window of a link name followed by URL's. A user can make a selection within this new links selection window. The links can then be retrieved and placed in a history folder to be thereafter retrieved.

SlipKnot's teachings of a separate links window would prevent the user from continuing to browse the previously presented hypermedia content, which is expressly against the teachings of the Applicants (column 9, lines 2-17; Example 1 from page 18; and throughout the Application), where the user selection of a hyperlink is to occur in a manner where the user can continue to browse content. SlipKnot's teachings fail to overcome shortcomings of prior art discussed in the background (user's missing portions of an A/V presentation and a researcher being distracted from the background examples).

More specifically, SlipKnot fails to explicitly or inherently teach a means for the user to select at least one hyperlink from within the content browser while the hypermedia content is displayed to the user and instead teaches that hyperlink selection is to occur instead of displaying hypermedia content to the user.

Additionally, Applicants claim that the download list manager is to download content during the presentation without a view currently presented in the content browser from being relinquished. SlipKnot does not teach this limitation, and does not provide a means for a user to select a hyperlink included within presented hypermedia content (so that the selected content is downloaded) without relinquishing the presentation of the content to the user.

Since SlipKnot fails to teach each claimed limitation, the 35 U.S.C. § 102(e) rejections to claims 22-24 should be withdrawn, which action is respectfully requested.

C. Helfman fails to cure the deficiencies of Mighdoll

Claims 10, 13, 41 and 44 have been rejected under U.S.C. § 103(a) as being unpatentable over Mighdoll in view of U.S. Patent No. 6,119,135 to Helfman (Helfman).

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Helfman teaches a method for passively browsing the Internet. Helfman teaches that images can be used as hyperlinks. Images can be retrieved from Web servers or can be retrieved from an image datastore.

It has been shown that Mighdoll fails to teach pro-active, user-initiated retrieval of Web content. Helfman, not cited for such teachings, fails to cure this deficiency. That is, neither Mighdoll, Helfman, nor combinations thereof explicitly or implicitly teach: presenting hypermedia content, said hypermedia content containing hyperlinks to additional hypermedia content; receiving a user selection of at least one of said hyperlinks; storing user selected ones of said hyperlinks in a delayed viewing list; and, caching hypermedia content associated with said stored hyperlinks during said presenting step, wherein the hypermedia content is presented to a user during said receiving, storing, and caching steps. Because each claimed limitation must be expressly or implicitly shown within a combination of references under U.S.C. § 103(a), the rejections to claims 10, 13, 41 and 44 should be withdrawn, which action is respectfully requested.

D. Altschuler fails to cure the deficiencies of Mighdoll

Claims 12 and 43 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mighdoll in view of Altschuler. Altschuler's teachings are dependent upon previous usage logs. Altschuler fails to teach the pro-active, user-initiated retrieval of Web content, and is not asserted for this teaching.

Neither Mighdoll, Altschuler, nor combinations thereof explicitly or implicitly teach: presenting hypermedia content, said hypermedia content containing hyperlinks to additional hypermedia content; receiving a user selection of at least one of said hyperlinks; storing user selected ones of said hyperlinks in a delayed viewing list; and, caching hypermedia content associated with said stored hyperlinks during said presenting step, wherein the hypermedia content is presented to a user during said receiving, storing, and caching steps. Because each claimed limitation must be

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expressly or implicitly shown within a combination of references under U.S.C. § 103(a), the rejections to claims 12 and 43 should be withdrawn, which action is respectfully requested.

E. Official Notice fails to cure the deficiencies of Mighdoll

Claims 14, 15, 17, 19, 45, 46, 48 and 50 are rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Mighdoll in view of "official notice".

Applicants have noted that Mighdoll fails to explicitly or implicitly teach each of the Applicants claimed limitations, and so the rejections to claims 14, 15, 17, 19, 45, 46, 48 and 50 should be withdrawn, which action is respectfully requested.

Additionally, Mighdoll teaches a proxy cache and does not teach a delayed viewing list containing user selected entries. It is a significant and heretofore unsupported inventive jump to bridge the gap between these two teachings. Applicants are not aware of any art that teaches that user initiated content fetches are purged in accordance to the Applicants claimed teachings or that user initiated content fetches are to have associated hyperlinks added to bookmarks of a content browser. Applicants do not believe that the officially noticed facts are common knowledge or capable of instant and unquestionable demonstration of being well-known. Accordingly, Applicants assert their right under MPEP 2144.04 to have the Examiner support the officially noticed concepts with adequate evidence.

F. SlipKnot fails to cure the deficiencies of Mighdoll

Claims 16, 18, 20, 47, 49, and 51 under 35 U.S.C. § 103(a) over Mighdoll in view of SlipKnot.

No proper motivation exists to combine the teachings of Mighdoll and SlipKnot. MPEP 2143.02 states that a proposed modification can not change the principle of operation of a reference. Mighdoll teaches a transcoding proxy between a client and a Web server. Slipknot teaches a client-based application. These architectures are not the

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same, and the claimed transcoding operational principles taught by Mighdoll would have to be modified if Mig's teachings were to be combined with the client based teachings of SlipKnot.

MPEP 2143.02 also states that a proposed modification cannot render prior art unsatisfactory for its intended purpose. The purpose of Mighdoll is to teach a transcoding proxy. Functions of Mighdoll, such as server-advised client prefetching of column 12 cannot be performed should the database upon which the prefetching be based be tightly coupled to the client, which is a prerequisite of implementing the client based application taught by SlipKnot.

MPEP 2143.01 states the level of ordinary skill in the art cannot be relied upon to provide the suggestion or motivation to combine the references. Instead, the suggestion must be contained within the references themselves and apparent to one of ordinary skill in the art having those references before him.

Mighdoll teaches a proxy initiated transcoding methodology. A user initiated method or motivations to expand the proxy driven techniques is not contained within Mighdoll. SlipKnot fails to provide these motivations as well. The Examiner stated motivation of adding user driven item tracking to Mighdoll's expressed functionality cannot be derived from Mighdoll's teachings. (Mighdoll focuses upon transcoding to permit TV viewing of media content). For all of the above, it is improper to combine teachings of Mighdoll with teachings of SlipKnot (in absence of some teachings that bridge the differences between the two and provide motivation for the combination).

Even if Mighdoll and SlipKnot were to be combined, SlipKnot fails to cure the deficiencies of Mighdoll. Specifically, SlipKnot teaches that a separate window is to be presented in which a user can select links. This window interrupts the user, preventing the user from browsing content containing the links.

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Accordingly, Mighdoll, SlipKnot, and combinations of the two fail to explicitly or implicitly teach that hypermedia content is presented to a user during said receiving, storing, and caching steps.

Since no proper motivation exists to combine Mighdoll and SlipKnot, and because the combination of the two fail to teach or suggest each claimed limitation, the rejections to claims 16, 18, 20, 47, 49, and 51 should be withdrawn, which action is respectfully requested.

G. Mighdoll fails to cure the deficiencies of SlipKnot

Claims 25-26 under 35 U.S.C. § 103(a) over SlipKnot in view of Mighdoll.

As previously mentioned, attempts to combine SlipKnot with Mighdoll render both unsatisfactory for their intended purpose and also require the operational principles of each to be modified, which is not permitted. Additionally, the stated motivation to combine the references, is not provided within the references themselves or apparent from the references (as they exist alone, instead of viewing the references in light of the Applicant's own disclosure).

Regardless, Mighdoll fails to cure the deficiencies of SlipKnot. Neither SlipKnot, Mighdoll, nor combinations thereof explicitly or implicitly teach a means for the user to select at least one hyperlink from within the content browser while the hypermedia content is displayed to the user and instead teaches that hyperlink selection is to occur instead of displaying hypermedia content to the user. In light of the above, the rejections to claims 25-26 should be withdrawn, which action is respectfully requested.

The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

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Respectfully submitted,

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